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AUG 22 2007

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

In re Application of
Maria Palasis
Serial No.: 09/542,935
Filed: April 4, 2000
Attorney Docket No.: 12013/56301

DECISION ON PETITION

This letter is in response to the Request for Reconsideration of a Petition Decision under 37 C.F.R. 1.181, filed July 2, 2007, to grant priority to earlier filed SN 09/204,254 (now US 6,369,039).

BACKGROUND

A review of the recent file history of this application is set forth in the previous petition decision issued April 27, 2007. That decision dismissed applicants' petition as being directed to an issue which could only be resolved at the Board of Patent Appeals and Interferences since the issue was intimately connected with a rejection of record.

DISCUSSION

Applicants request reconsideration based on the argument that "Whether the present claims are entitled to the priority date of U.S. Patent No. 6,369,039 turns on whether there is support for the present claims in U.S. Patent No. 6,369,039." Also, "The written description rejection turns on whether there is written description support for the present claims in the present application."

Applicants' arguments are partially correct. A claim in an application must have proper written description support in the specification with which it is filed. In order for that same claim to have an earlier priority date, there must be a claim to an earlier application which has the same written description support as the instant application.

In this particular instance the examiner has indicated that the earlier application on which a priority claim is based does not provide written description for the instantly claimed invention and thus the earlier priority date for the invention has been denied. Applicants have not been denied a claim of priority to the earlier application, only priority for the instantly claimed

invention. Since the determination of whether proper written description exists in the earlier application for the instantly claimed invention is tied to a rejection under 35 U.S.C. 112, first paragraph, the issue cannot be resolved by petition, but must be resolved at the Board of Patent Appeals and Interferences.

DECISION

The petition is again **DISMISSED** as moot in that it is not directed to a petitionable matter.

Applicant remains under obligation to file an Appeal Brief within the time period provided, or as extended under 37 CFR 1.136(a).

Any request for reconsideration of this decision must be filed within TWO MONTHS of the mailing date thereof in order to be considered timely.

Should there be any questions regarding this decision, please contact Special Program Examiner William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0519 or by Official Fax at 571-273-8300



Christopher Low
Director, Technology Center 1600 (Acting)